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PTO/SB/21 (09-04)

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TRANSMITTAL FORM

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Total Number of Pages in This Submission

3

Application Number

10/053,304

Filing Date

November 7, 2001

First Named Inventor

David P. Vellante

Art Unit

3639

Examiner Name

Fadey S. Jabr

Attorney Docket Number

ITC 2-002

ENCLOSURES (Check all that apply)

☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐

Reply to Missing Parts/
Incomplete Application

☐

Reply to Missing Parts
under 37 CFR 1.52 or 1.53

☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐

Petition to Convert to a
Provisional Application

☐

Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

☐

Request for Refund

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CD, Number of CD(s) _____

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Landscape Table on CD

☐

After Allowance Communication to TC

☐

Appeal Communication to Board
of Appeals and Interferences

☐

Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

☐

Proprietary Information

☐

Status Letter

☒

Other Enclosure(s) (please identify
below):

Remarks

Response to Restriction Requirement

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Mueller and Smith, LPA

Signature

Diane E. Burke

Printed name

Diane E. Burke

Date

October 24, 2005

Reg. No.

45,725

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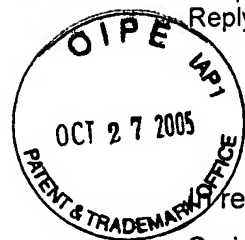
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October 24, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of : David P. Vellante, et al.
Serial No. : 10/053,304
Filed: : November 7, 2001
For: : Method for Assessing the Business Value of Information
Technology
TC/AU : 3639
Examiner : Fadey S. Jabr
Attorney Docket No. : ITC 2-002

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is a response to the October 17, 2005 Office Action containing a restriction requirement.

It is noted that the restriction has been called for with respect to two inventions identified as Inventions I and II. Invention I includes claims 1-14 and 27-30, while Invention II includes claims 15-26. Applicant provisionally elects, with traverse, Invention I including claims 1-14 and 27-30.

Section 121 of the Patent Statute authorizes a requirement for restriction only when two or more independent and distinct inventions are claimed in one application. The two inventions identified above clearly are dependent in that each is related to the other in operation or effect. The Statute requires both independence and distinctness, not either, and provides such requirement in definite terms. The construction adopted by the Manual of Patent Examining Procedure assumes that the Statute authorizes restriction between inventions which are not independent and distinct, but which are either independent or distinct. It is Applicant's position that the plain meaning of the Statute defies such construction. For this reason, Applicant requests that the restriction requirement be withdrawn so that the claims in controversy may be prosecuted as a single invention.

Respectfully submitted,

Date: Oct. 24, 2005

Diane E. Burke

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Jane Keeney
Jane Keeney